

REMARKS

Claims 1-4 and 6-10 are all the claims now pending in the application. Claims 6-10 are added as new claims. Claim 5 has been canceled.

I. Claim Rejections under 35 U.S.C. § 102

Claims 1-3 and 5 stand rejected under 35 U.S.C. § 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over Shimosaka et al. (U.S. Patent No. 5,816,937). To be an “anticipation” rejection under 35 U.S.C. § 102, the reference must teach every element and limitation of the Applicant’s claims. Rejections under 35 U.S.C. § 102 are proper only when the claimed subject matter is identically disclosed or described in the prior art. Moreover, to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a) the Examiner must show that the prior art references, when combined, teach or suggest all of the claim limitations. *See MPEP § 2143*. As a result, in order for the Examiner to maintain a rejection under either 35 U.S.C. § 102 or 103, the references must teach or suggest all of the limitations of the claims. Applicant respectfully submits that the references cited above by the Examiner fail to teach or suggest all of the claim limitations as set forth in the present invention.

Specifically, Shimosaka fails to teach or suggest an intermediate layer having a gage of 0.8 to 1.5 mm. Shimosaka discloses a golf ball comprises a core 1 and an innermost cover layer 3, an intermediate cover layer 4 and an outermost cover layer 5. However, as the Examiner acknowledges, the gage of the alleged intermediate cover layer 4 of Shimosaka is 1.7-2.5 mm which is outside the claimed range of 0.8 to 1.5 mm. Accordingly, Shimosaka fails to teach or suggest an intermediate layer having a gage of 0.8 to 1.5 mm.

Additionally, Applicant submits that the intermediate cover layer 4 of Shimosaka does not teach the claimed intermediate layer of claim 1. Claim 1 recites that the intermediate layer encloses the core and is enclosed by the cover. In other words, the intermediate layer is formed between the core and the cover. As shown in Fig. 1 of Shimosaka, the innermost cover layer 3 encloses the core 1, and is enclosed by the intermediate cover layer 4. However, the outermost cover layer 5 encloses the intermediate cover layer 4. Thus, there are two layers disposed between the cover 5 and the core 1. Therefore, Applicant submits that the combination of the innermost cover layer 3 and the intermediate cover layer 4 should properly be considered the intermediate layer since they are the layers disposed between the cover and the core. As a result, the total gage of the innermost cover layer and the intermediate cover disclosed in Shimosaka is 2.7 to 4.5 mm ($1.0 + 1.7$ mm to $2.0 + 2.5$ mm), which clearly outside the claimed gage of 0.8 to 1.5 mm.

Finally, Shimosaka does not disclose the claimed relationship between the thickness of the intermediate layer and the cover. While the Examiner attempts to substitute random numbers into the claimed equation, as discussed above, the values for the intermediate cover layer 4 of Shimosaka do not equate to the intermediate layer of claim 1. Furthermore, Shimosaka fails to recognize that the thickness of the intermediate layer and cover are related to the initial velocity of the golf ball as a whole. Since Shimosaka does not recognize that the relationship of the thicknesses is relevant to the initial velocity, Applicant submits that it would not have been obvious to one skilled in the art to simply optimize these variable as the Examiner has suggested.

In view of the above remarks, Applicant submits that Shimosaka fails to teach or suggest all of the limitations of claim 1. Therefore Applicant requests that the rejection of claim 1 under either 35 U.S.C. § 102(b) or 103(a) be reconsidered and withdrawn. Since claims 2-3 and 5 depend from claim 1, and since the Shimosaka reference does not disclose all of the limitations of claim 1, Applicant submits that claims 2-3 and 5 are patentable at least by virtue of their dependency from claim 1. Accordingly, Applicant respectfully requests that the rejections of claims 2-3 and 5 under 35 U.S.C. § 102(b) and/or 103(a) be reconsidered and withdrawn.

Claims 1-2 stand rejected under 35 U.S.C. § 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over Sullivan et al. (U.S. Patent No. 5,803,831). Sullivan also fails to teach or suggest all of the limitations of claim 1. Specifically, Sullivan fails to teach or suggest a cover formed of a urethane resin. The outer cover layer of Sullivan is formed from an ionomeric resin which is quite different from the urethane resin of claim 1. *See Sullivan col. 15:15-30.*

Finally, the primary object of Sullivan appears to be different from that of the present invention. The present invention increases the total distance that the ball travels upon full shots with a driver. One of the novel features being that the relationship between the thickness of the cover and intermediate layer directed influence the distance of the golf ball upon full shots with a driver. In contrast, Sullivan does not recognize that the golf ball's distance can be influenced by the combination of the intermediate layer gage with the cover gage ($[(G1/(G1+G2))] \times 100$). Since Sullivan does not recognize that the relationship of the thicknesses is relevant to the distance that the golf ball travels upon full shots with a driver, Applicant submits that it would

not have been obvious to one skilled in the art to simply optimize these variable as the Examiner has suggested.

In view of the above remarks, Applicant submits that Sullivan fails to teach or suggest all of the limitations of claim 1. Therefore Applicant requests that the rejection of claim 1 under either 35 U.S.C. § 102(b) or 103(a) be reconsidered and withdrawn. Since claim 2 depends from claim 1, and since the Sullivan reference does not disclose all of the limitations of claim 1, Applicant submits that claim 2 is patentable at least by virtue of its dependency from claim 1. Accordingly, Applicant respectfully requests that the rejection of claim 2 under 35 U.S.C. § 102(b) and/or 103(a) be reconsidered and withdrawn.

II. Claim Rejections under 35 U.S.C. § 103

Claim 4 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over the references above, in view of Ichikawa et al. (U.S. Patent No. 5,872,185). Since claim 4 depends upon claim 1 and since Ichikawa does not cure the deficient teachings of Shimosaka or Sullivan with respect to claim 1, Applicant submits that claim 4 is patentable at least by virtue of its dependency from claim 1.

Furthermore, regarding the melt index of at least 3.0 dg/min at 190°C of the cover material in claim 4, Ichikawa only describes that the ionomer resin to be blended with the thermoplastic elastomer should have a melt index of at least 3 g/10min at 1.90°C. However, the resin material of the melt index disclosed in Ichikawa is an ionomer resin, which is quite different from an urethane resin of the present invention.

AMENDMENT UNDER 37 C.F.R. § 1.111
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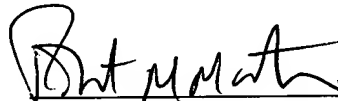
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Therefore, in view of the above remarks, Applicant respectfully requests that the rejection of claim 4 under 35 U.S.C. § 103(a) be reconsidered and withdrawn.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

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